

CAT/34-SCRO-US



197 2163

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE ET AL.

SERIAL NO.: 08/873,974

GROUP ART UNIT: 2163

CPA FILED: AUGUST 17, 1999

EXAMINER: ROBINSON, BOYCE A.

FOR: SYSTEM AND METHOD FOR
DISTRIBUTING INFORMATION
THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES

ASSISTANT COMMISSION FOR PATENTS
WASHINGTON, D.C. 20231

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GROUP 3600 Technology Center 2100

SIR:

In response to the remand of this application from the CAFC to the USPTO, please consider the following remarks.

REMARKS

Copies of the papers listed below are submitted herewith. These papers are part of the record in the child application, 09/505,632; docket number CAT/34-SCRO-CCP.

- (1) copy of amendment in application 09/505,632; docket number CAT/34-SCRO-CCP; filed 12/8/2003;
- (2) copy of Office action in 09/505,632; docket number CAT/34-SCRO-CCP; mailed 04/06/2004 (Final Rejection);
- (3) copy of Petition in 09/505,632; docket number CAT/34-SCRO-CCP; filed 06/10/2004;
- (4) copy of Notice of Appeal/Appeal Brief in 09/505,632; docket number CAT/34-SCRO-CCP; filed 07/02/2004;
- (5) copy of Office action in 09/505,632; docket number CAT/34-SCRO-CCP; mailed 10/21/2004

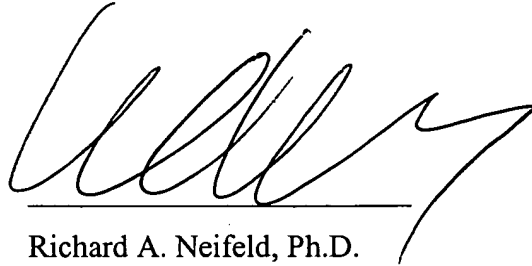
(Withdrawal of Final Rejection);

(6) copy of Notice of appeal in 09/505,632; docket number CAT/34-SCRO-CCP; filed January 19, 2005; and

(7) Remarks.

Date

5/6/2004



Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Date/time: May 6, 2005 (5:37pm)

Y:\Clients\Catalina\CAT-34-SCRO\CAT34-SCRO-US\Drafts\Remarks_050502.wpd

2/9/03
cs



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THIS IS A FILING RECEIPT

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Neifeld IP Law Docket No.: CAT/34-SCRO-CCP

Application Serial No.: 09/505,632

Filed: 02/16/00

Inventor: MICHAEL C. SCROGGIE, et al.

Title: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION
THROUGH COOPERATIVE COMMUNICATION NETWORK SITES

The following has been received in the U.S. Patent Office on the date stamped hereon:

AMENDMENT COVER LETTER/AUTHORIZATION TO CHARGE DEPOSIT (IN DUPLICATE)
AMENDMENT AFTER APPEAL DECISION (8 PAGES)

STATUS CHECK: 2/8/04

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Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\FR_031205wpd.wpd

Am-CAT34SCROCCP_031209 cs

Docket No. CAT/34-SCRO-CCP
IN RE APPLICATION OF: Scroggie et al.
SERIAL NO: 09/505,632
FILED: 2/16/00
FOR: System and Method for Distributing Information Through Cooperative Communication Network Sites
ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313



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**AMENDMENT COVER LETTER
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☐ Additional documents filed herewith:

The Fee has been calculated as shown below:

he Fee has been calculated as shown below.

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATION S	
TOTAL	20	MINUS	26	0	× \$18 =	\$0.00	
INDEPENDENT	7	MINUS	12	0	× \$86 =	\$0.00	
		<input type="checkbox"/>	MULTIPLE DEPENDENT CLAIMS			+ \$290 =	\$0.00
		TOTAL OF ABOVE CALCULATIONS					\$0.00
		<input type="checkbox"/>	Reduction by 50% for filing by Small Entity				\$0.00
		<input type="checkbox"/>	Recordation of Assignment			+ \$40 =	\$0.00
		<input type="checkbox"/>	Petition for Extension of Time: 1 Month			+ \$110 =	\$0.00
		<input type="checkbox"/>	2 Months			+ \$420 =	\$0.00
		<input type="checkbox"/>	3 Months			+ \$950 =	\$0.00
		<input type="checkbox"/>	4 Months			+ \$1,480 =	\$0.00
		<input type="checkbox"/>	Terminal Disclaimer			+ \$130 =	\$0.00
		<input type="checkbox"/>	Information Disclosure Statement Prior to Final			+ \$180 =	\$0.00
		<input type="checkbox"/>	Other:				
		<input type="checkbox"/>					
TOTAL						\$0.00	

☐ A check including the amount of \$0.00 is attached.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE

Date

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Respectfully Submitted,

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11.
6-15-04 RB

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NODATESET

Neifeld Docket No.: CAT/34-SCRO-CCP

Application Serial No.: 09/505,632

Filed: 02/16/00

Inventor: MICHAEL C. SCROGGIE, et al.

Title: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION
THROUGH COOPERATIVE COMMUNICATION NETWORK SITES



The following has been received in the U.S. Patent Office on the date stamped hereon:

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TRANSMITTAL LETTER/AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT (IN DUPLICATE)

37 CFR 1.181 PETITION FOR WITHDRAWAL OF AN OFFICE ACTION, REMOVAL OF FINAL STATUS,
AND ISSUANCE OF A NOTICE OF ALLOWANCE

ATTACHMENTS 1 - 3

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NEIFELD IP LAW, PC

DATE : Jun 9/2004

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PAYMENT

INVOICE

001932

CHE # : 01932

: 130.00

AMOUNT: \$130.00

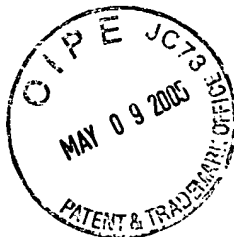
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CAT/34-SCRO-CCP, gov. fee for Petition to Withdrawal.

VENDOR NAME: Commissioner of Patents

VENDOR ACCT:

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2001 JEFFERSON DAVIS HIGHWAY, SUITE 1001
ARLINGTON, VA 22202

BURKE & HERBERT BANK & TRUST CO.
Alexandria, VA

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Washington, DC 20231

DATE

Jun 9/2004

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⑈001932⑈ ⑆056001066⑆ ⑈07710349⑈2⑈

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DATE : Jun 9/2004

001932

CHE # : 01932

AMOUNT: \$130.00

ACCOUNT: 1

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VENDOR NAME: Commissioner of Patents

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CAT/34-SCRO : 130.00

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6-9-04 RLB

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TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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Technology Center 2100

RE: Attorney Docket No.: CAT/34-SCRO-CCP
Application Serial No.: 09/505,632
Filed: 02/16/00
Title: SYSTEM AND METHOD FOR DISTRIBUTING
INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES
Inventor: MICHAEL C. SCROGGIE, et al.
Group Art Unit: 2163
Examiner: AKIKA ROBINSON-BOYCE

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.181 PETITION FOR WITHDRAWAL OF AN OFFICE ACTION, REMOVAL OF
FINAL STATUS, AND ISSUANCE OF A NOTICE OF ALLOWANCE
ATTACHMENTS 1 - 3

Our check in the amount of \$130.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106.

31518

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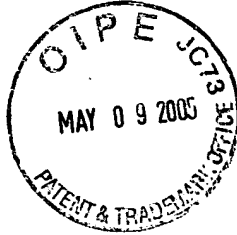
Date

A handwritten signature in black ink, appearing to read "Richard A. Neifeld".

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\TransLtr_040609.wpd

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TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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Technology Center 2100

RE: Attorney Docket No.: CAT/34-SCRO-CCP
Application Serial No.: 09/505,632
Filed: 02/16/00
Title: SYSTEM AND METHOD FOR DISTRIBUTING
INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES
Inventor: MICHAEL C. SCROGGIE, et al.
Group Art Unit: 2163
Examiner: AKIKA ROBINSON-BOYCE

SIR:

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37 CFR 1.181 PETITION FOR WITHDRAWAL OF AN OFFICE ACTION, REMOVAL OF
FINAL STATUS, AND ISSUANCE OF A NOTICE OF ALLOWANCE
ATTACHMENTS 1 - 3

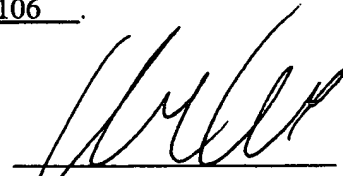
Our check in the amount of \$130.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE


Date


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Attorney of Record

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GROUP 3600



NEIFELD Docket No.: CAT/34-SCRO-CCP

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP ART UNIT: 2163

MICHAEL C. SCROGGIE, et al.

SERIAL NO.: 09/505,632

EXAMINER: AKIKA ROBINSON-BOYCE

FILED: 02/16/00

FOR: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH
COOPERATIVE COMMUNICATION NETWORK SITES

Assistant Commissioner for Patents

Washington, D.C. 20231

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37 CFR 1.181 PETITION FOR WITHDRAWAL OF AN OFFICE ACTION, REMOVAL OF
FINAL STATUS, AND ISSUANCE OF A NOTICE OF ALLOWANCE

I. Statement of Precise Relief Requested

The applicant requests that the Director (1) remove the "final status" of this application, (2) withdraw the final office action mailed April 6, 2004, and (3) issue a notice of allowance.

II. Statement of Material Facts

1. On October 27, 2003, the Board mailed a decision on the **appeal** in this application.
2. The October 27, 2003 decision (1) reversed the prior art rejections of claims 28, 40, 24-27, 29-31, 36-39, 41-43, 48, and 49 **based solely upon the Sloane, Hoffman, and Smolen references** and (2) sustained the rejections of claims 34 and 46.
3. The Board decision contains no suggestion or instruction to reject or new rejection of any claim.
4. A copy of the Board decision mailed October 27, 2003 is attachment 1.
5. On April 6, 2004, the USPTO mailed a "final" office action. (The April 6, 2004 office action states that it is "FINAL".)
6. The April 6, 2004 final office action imposes rejection of claims 28, 40, 24-27, 29-31, 36-

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39, 41-43, 48, and 49 based solely upon Sloane, Hoffman, and Smolen.

7. The April 6, 2004 office action also rejects new claim 50 and 51 based solely on Sloane. However, new claims 50 and 51 define subject matter that the Board held to not be taught by Sloane, Hoffman, and Smolen. See page 7 of the amendment filed December 8, 2003.
8. A copy of the amendment filed December 8, 2003 is attachment 3.
9. The April 6, 2004 office action is not signed by a Group director, and it does not otherwise the Group director authorized reopening of prosecution after a decision on appeal.
10. The MPEP indicates that Group director must specifically approve reopening prosecution after a decision on appeal.
11. A copy of the April 6, 2004 office action is attachment 2.

III. Reasons Why the Relief Requested Should be Granted

The examiner is not authorized to reopen prosecution without the authority and presumably signature proving such of the Group director, after a decision on an appeal. Accordingly, the mailing of an office action is improper and should be withdrawn.

The rejections in the office action are barred by res judicata, since all issues that were and could have been raised are decided by an appeal. Clearly the almost identical set of rejections based upon the exact same three references imposed in the April 6, 2004 office action are barred by the decision on the same evidence and essentially the same arguments in the appeal.

In any case, final status is improper when an examiner opens prosecution, final status is improper when an examiner imposes a new rejection not necessitated by action by the applicant, and both of those situations exist here.

Given that the Director's policy warrants that the unauthorized office action be withdrawn and that the basis for rejections in the office action is precluded as a matter of law, the only action open to the USPTO is to issue a notice of allowance. Accordingly, the relief requested should be granted in full, and a decision on this petition should so instruct the examiner.

Respectfully Submitted

6/9/04

Date

[Signature]

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

31518

PATENT TRADEMARK OFFICE

RAN

Date/Time: June 9, 2004 (2:27pm)

Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\Petition_040609.wpd

Attachment 1

11/13/03
CS

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

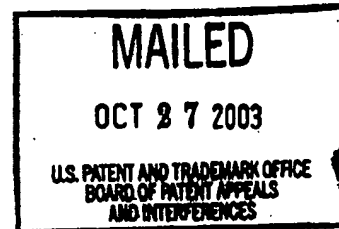
REVIEW DATE: 11/27/03

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2002-0329
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges,

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

APDEC-CAT34SCROCCP-031103 CS

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

Smolen	5,915,243	Jun. 22, 1999 (filed Aug. 29, 1996)
Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)

Appeal No. 2002-0329
Application No. 09/505,632

Hoffman et al. (Hoffman) 6,012,039 Jan. 4, 2000
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected
under 35 U.S.C. § 103. As evidence of obviousness, the examiner
cites Sloane and Hoffman with regard to claims 24, 25, 27, 29,
36, 37, 39, 41, 48 and 49, adding Smolen to this combination with
regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the
respective positions of appellants and the examiner.

OPINION

Turning, initially, to the rejection under 35 U.S.C.
§ 102(e), an anticipatory reference is one which describes all of
the elements of the claimed invention so as to have placed a
person of ordinary skill in the art in possession thereof. In re
Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at
column 7, lines 5-10, the transmission from a consumer computer
of a request for manufacturer incentives; at column 7, lines 13-

Appeal No. 2002-0329
Application No. 09/505,632

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

Appeal No. 2002-0329
Application No. 09/505,632

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

Appeal No. 2002-0329
Application No. 09/505,632

corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

Appeal No. 2002-0329
Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

JOSEPH F. RUGGIERO
Administrative Patent Judge

EK/RWK

Appeal No. 2002-0329
Application No. 09/505,632

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9/17/04
03



UNITED STATES PATENT AND TRADEMARK OFFICE

Attachment Z

UNITED STATES DEPARTMENT OF COMMERCE
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,632	02/16/2000	Michael C. Scroggie	CAT/34-SCRO-CCP	5917
31518	7590	04/06/2004	EXAMINER	
NEIFELD IP LAW, PC 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			ROBINSON BOYCE, AKIBA K	
			ART UNIT	PAPER NUMBER
			3623	

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DATE MAILED: 04/06/2004

RESPONSE DUE: 7/16/04
REMINDER: 6/16/04
BAR DATE: 10/16/04

Please find below and/or attached an Office communication concerning this application or proceeding.

WORKING COPY

OA-CAT34SCROCCP-040407 CB

Office Action Summary	Application No. 09/505,632	Applicant(s) SCROGGIE ET AL.	
	Examiner Akiba K Robinson-Boyce	Art Unit 3623	<i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 24-31, 36-43, 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. The following office action is in response to an amendment submitted after a decision by the Board of Patent Appeals and Interferences, which was affirmed. The following is a final office action. Claim 34 and 46 have been cancelled. Claims 50 and 51 have been added. Claims 1-24-31, 36-43 and 48-51 are pending in this application and have been examined on the merits.

Claim Objections

2. Claims 50 and 51 are objected to because of the following informalities: in the 3rd line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50 and 51 recites the limitation "transmission from the a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "mean for transmitting from the a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is Insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 28, 40, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 40, Sloane discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 7, lines 5-10); ✓

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 7, lines 13-22); ✓

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in response to receipt of said request at said remote site,
transmitting from said remote site over the Internet to said Web site of said
retailer a list of manufacturer incentives/means for transmitting from said
remote site over the Internet to said Web site of said retailer a list of
manufacturer incentives; (Col. 7, lines 22-26); ✓

in response to receipt of said manufacturers incentives at said Web site of
said retailer, transmitting over the Internet to said consumer computer said list of
manufacturers incentives/means for transmitting over the Internet to said
consumer computer said list of manufacturers incentives, (Col. 8, lines 3-7). ✓

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-
10);

Transmission from the retailer website to a remote website, (Col. 7, lines
13-22), and

Transmission from the remote website to the to the retailer website, of a
list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website, (Col. 7,
lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col.
7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a
list of manufacturer incentives, (Col. 7, lines 22-26).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35

U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:

transmitting...at least one name.../means for transmitting...at least one name...(Col. 11, lines 1-9 read with Col. 13, lines 5-10).

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the

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desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following,
however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffinan, et al discloses:
transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details...lmeans for transmitting from said remote site...(Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(Col. 6, lines 62-63).

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It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 9, lines 52-58, Claim 12, Claim 15).

9. Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data

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can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data...(Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.
April 2, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

2/9/03
cb

Attachment 3



Neifeld IP Law, P.C.
Crystal Plaza 1, Suite 1001
2001 Jefferson Davis Highway
Arlington, VA 22202

THIS IS A FILING RECEIPT

RECEIVED

MAY 16 2005

Technology Center 2100

Neifeld IP Law Docket No.: CAT/34-SCRO-CCP

Application Serial No.: 09/505,632

Filed: 02/16/00

Inventor: MICHAEL C. SCROGGIE, et al.

Title: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION
THROUGH COOPERATIVE COMMUNICATION NETWORK SITES

The following has been received in the U.S. Patent Office on the date stamped hereon:

AMENDMENT COVER LETTER/AUTHORIZATION TO CHARGE DEPOSIT (IN DUPLICATE)
AMENDMENT AFTER APPEAL DECISION (8 PAGES)

STATUS CHECK: 2/8/04

RECEIVED

MAY 19 2005

GROUP 3600

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Am-CAT34SCROCCP_031209 cb

Docket No. CAT/34-SCRO-CCP

IN RE APPLICATION OF: Scroggie et al.

SERIAL NO: 09/505,632

FILED: 2/16/00

FOR: System and Method for Distributing Information Through Cooperative Communication Network Sites

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

**AMENDMENT COVER LETTER
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☐ Additional documents filed herewith:

The Fee has been calculated as shown below:

	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATION \$
TOTAL	20	MINUS	26	0	× \$18 =	\$0.00
INDEPENDENT	7	MINUS	12	0	× \$86 =	\$0.00
		<input type="checkbox"/>	MULTIPLE DEPENDENT CLAIMS			+ \$290 = \$0.00
			TOTAL OF ABOVE CALCULATIONS			\$0.00
		<input type="checkbox"/>	Reduction by 50% for filing by Small Entity			\$0.00
		<input type="checkbox"/>	Recordation of Assignment		+ \$40 =	\$0.00
		<input type="checkbox"/>	Petition for Extension of Time: 1 Month		+ \$110 =	\$0.00
		<input type="checkbox"/>	2 Months		+ \$420 =	\$0.00
		<input type="checkbox"/>	3 Months		+ \$950 =	\$0.00
		<input type="checkbox"/>	4 Months		+ \$1,480 =	\$0.00
		<input type="checkbox"/>	Terminal Disclaimer		+ \$130 =	\$0.00
		<input type="checkbox"/>	Information Disclosure Statement Prior to Final		+ \$180 =	\$0.00
		<input type="checkbox"/>	Other:			
			TOTAL			\$0.00

☐ A check including the amount of **\$0.00** is attached.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE

12/15/03
Date

Respectfully Submitted,

Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Tel: 703-415-0012

Fax: 703-415-0013

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2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

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Docket No. CAT/34-SCRO-CCP

IN RE APPLICATION OF: Scroggie et al.

SERIAL NO: 09/505,632

FILED: 2/16/00

FOR: System and Method for Distributing Information Through Cooperative Communication Network Sites

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

**AMENDMENT COVER LETTER
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☐ Additional documents filed herewith:

The Fee has been calculated as shown below:

	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATION \$
TOTAL	20	MINUS	26	0	× \$18 =	\$0.00
INDEPENDENT	7	MINUS	12	0	× \$86 =	\$0.00
		<input type="checkbox"/>	MULTIPLE DEPENDENT CLAIMS			+ \$290 = \$0.00
			TOTAL OF ABOVE CALCULATIONS			\$0.00
		<input type="checkbox"/>	Reduction by 50% for filing by Small Entity			\$0.00
		<input type="checkbox"/>	Recordation of Assignment			+ \$40 = \$0.00
		<input type="checkbox"/>	Petition for Extension of Time: 1 Month			+ \$110 = \$0.00
		<input type="checkbox"/>	2 Months			+ \$420 = \$0.00
		<input type="checkbox"/>	3 Months			+ \$950 = \$0.00
		<input type="checkbox"/>	4 Months			+ \$1,480 = \$0.00
		<input type="checkbox"/>	Terminal Disclaimer			+ \$130 = \$0.00
		<input type="checkbox"/>	Information Disclosure Statement Prior to Final			+ \$180 = \$0.00
		<input type="checkbox"/>	Other:			
			TOTAL			\$0.00

☐ A check including the amount of \$0.00 is attached.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE

Date

Respectfully Submitted,

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NEIFELD DOCKET NO: CAT/34-SCRO-CCP
PRIOR ATTORNEY DOCKET NO: 7791-0103-25XCONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE ET AL. CONFIRMATION NO.

US APPLICATION NO: 09/505,632

DATE OF ENTRY INTO THE NATIONAL STAGE: N/A

GROUP ART UNIT: 2163

EXAMINER: ROBINSON-BOYCE, A.

**TITLE: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH
COOPERATIVE COMMUNICATION NETWORK SITES**

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

AMENDMENT AFTER APPEAL DECISION

Sir:

**In response to the Decision on Appeal mailed 10/17/2003, please amend this application
as follows:**

**Amendments to the Claims are reflected in the listing of claims which begin on page 2 of this
paper.**

Remarks/Arguments begin on page 7 of this paper.

IN THE CLAIMS:

24. (Original) A computer network implemented method, comprising the steps of:
transmitting from a consumer computer over the Internet to a Web site of a manufacturer
a request for manufacturer incentives to purchase one of a product and a service offered by said
manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said
Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from
said remote Web site to said Web site of said manufacturer at least one manufacturer incentive
and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer
computer said at least one manufacturer incentive and said at least one name and address.

25. (Original) The method according to claim 24, wherein said step of transmitting from
said remote site further comprises transmitting a link to a Web site of said retailer.

26. (Original) The method according to claim 24, further comprising the step of
determining said at least one manufacturer's incentive and said at least one name and address of a
retailer by querying, using said region data, a database from a server of said remote Web site.

27. (Original) The method according to claim 24, further comprising the steps of:
transmitting from said consumer computer to said Web site of said manufacturer selection
data indicating selection of said at least one manufacturer incentive;

transmitting from said Web site of said manufacturer to said remote site said selection
data;

transmitting from said remote site to said Web site of said manufacturer details of the
selected at least one manufacturer incentive; and

transmitting from said Web site of said manufacturer to said consumer computer said
details.

28. (Original) A computer network implemented method, comprising the steps of:
transmitting from a consumer computer over the Internet to a Web site of a retailer a
request for manufacturer incentives to purchase one of a product and a service offered by a
manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. (Original) The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. (Original) The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. (Original) The method according to claim 30, wherein said region data is postal code data.

32-35. (Canceled)

36. (Original) A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. (Original) The system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. (Original) The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. (Original) The system according to claim 36, further comprising:

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. (Original) A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. (Original) The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

42. (Original) The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. (Original) The system according to claim 42, wherein said region data is postal code data.

44-47. (Canceled)

48. (Original) A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. (Original) A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

50. (New) A computer implemented method comprising performing transactions involving multiple separate entities, including
transmission from the a consumer to a retailer website,
transmission from the retailer website to a remote website, and
transmission from the remote website to the retailer website, of a list of manufacturer incentives.

51. (New) A system comprising structure for performing transactions involving multiple separate entities, including:
mean for transmitting from the a consumer to a retailer website,
means for transmitting from the retailer website to a remote website, and
means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives.

REMARKS

I. The Status of All Claims

The Board sustained the rejections of Claims 34 and 46. The applicant hereby cancels claims 34 and 46.

II. Relevant Portion of the Panel's Opinion

The Board reversed the rejections of claims 24-31, 36-43, 48, and 49. In reversing the rejections of claims 24-31, 36-43, 48, and 49, the panel stated that:

With regard to the rejections under 35 U.S.C. 103, we will not sustain these rejections because each of the independent claims 24, 36, 48, and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from the a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer web site transmits to the consumer a list of these incentives. {Decision page 9 lines 10.}

Accordingly, the applicant presents a method claim and a system claim commensurate in scope with and mirroring the wording in the panel's description of the independent claimed inventions. These new claims are claims 50 and 51. Since these claims are essentially identical in scope to the panel's description of applicant's claimed invention, they are allowable over the art cited by the examiner for the same reasons applying to the appealed claims. Therefore, no new issues are raised. Accordingly, the examiner should enter and allow these claims when passing this application to issuance.

III. Closure

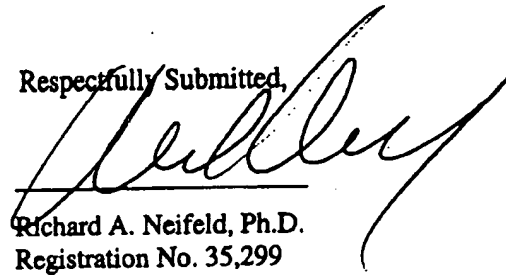
Should the examiner have any questions, he is urged to contact the undersigned at 703-415-0012.

12/4/03
Date

31518

PATENT TRADEMARK OFFICE

Respectfully Submitted,


Richard A. Neifeld, Ph.D.
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Attorney of Record
Irina Zemel, Ph.D.
Registration No. 43,402

Printed: December 4, 2003 (5:46pm)

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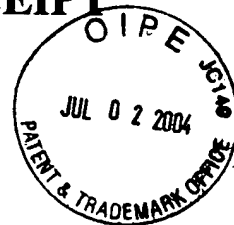
Neifeld Docket No.: CAT/34-SCRO-CCP

Application Serial No.: 09/505,632

Filed: 02/16/00

Inventor: MICHAEL C. SCROGGIE et al.

Title: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION
THROUGH COOPERATIVE COMMUNICATION NETWORK SITES



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ATTACHMENT 1 (IN TRIPLICATE)

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 MATTER: CAT/34-SCRO

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CLIENT: CATA - Catalina Marketing Corporation

MATTER: CAT/34-SCRO

LAWYER: Richard A. Neifeld

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TRANSMITTAL LETTER

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RE: Attorney Docket No.: CAT/34-SCRO-CCP
Application Serial No.: 09/505,632
Filed: 02/16/00
Title: SYSTEM AND METHOD FOR DISTRIBUTING
INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES
Inventor: MICHAEL C. SCROGGIE, et al.
Group Art Unit: 2163
Examiner: AKIBA ROBINSON-BOYCE

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SIR:

Attached hereto for filing are the following papers:

GROUP 3600

NOTICE OF APPEAL (IN DUPLICATE)
37 CFR 1.192 APPEAL BRIEF (IN TRIPLICATE)
ATTACHMENT 1 (IN TRIPLICATE)
AMENDMENT COVER LETTER AND AUTHORIZATION TO CHARGE DEPOSIT
ACCOUNT (IN DUPLICATE)
37 CFR 1.111 AMENDMENT

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The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106

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7/2/04
Date

[Signature]
Richard A. Neifeld, Ph.D.
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Attorney of Record

Printed: July 2, 2004

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TRANSMITTAL LETTER

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Technology Center 2100

RE: Attorney Docket No.: CAT/34-SCRO-CCP
Application Serial No.: 09/505,632
Filed: 02/16/00
Title: SYSTEM AND METHOD FOR DISTRIBUTING
INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES
Inventor: MICHAEL C. SCROGGIE, et al.
Group Art Unit: 2163
Examiner: AKIBA ROBINSON-BOYCE

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37 CFR 1.111 AMENDMENT

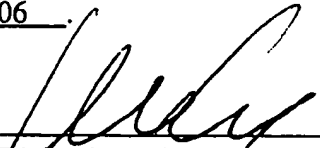
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The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

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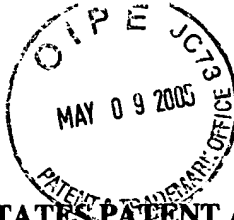
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Richard A. Neifeld, Ph.D.
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Attorney of Record

Printed: July 2, 2004

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Docket No. CAT/34-SCRO-CCP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Michael C. SCROGGIE et al.

GAU: 3623

SERIAL NO: 09/505,632

EXAMINER ROBINSON-BOYCE

FILED: February 16, 2000

FOR: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES

NOTICE OF APPEAL

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WASHINGTON, D.C. 20231

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Applicants hereby appeal to the Board of Appeals from the final office action dated _____ and further in view of the amendment after final filed on _____.

The items checked below are appropriate:

☐ A Petition for Extension of Time Under 37 C.F.R. §1.136 was filed for _____ months.

☐ A timely response to the final rejection was filed on _____, as provided in 841 O.G. 1411.

☐ An Appeal Brief being filed herewith.

☐ A Petition for Extension of Time for filing the Notice of Appeal is attached.

☐ Applicant claims small entity status. See 37 C.F.R. §1.27.

☒ 37 C.F.R. §1.17(b) Notice of Appeal fee is enclosed.

☒ 37 C.F.R. §1.17(c) Appeal Brief fee is enclosed.

Total Appeal fees enclosed: \$660.00.

☒ Please charge any additional fees or credit any overpayment of fees required for filing the Notice of Appeal to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.

☒ If this notice is not considered timely filed by the U.S. Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.

Respectfully Submitted,

7/2/04
Date

Richard A. Neifeld
Richard A. Neifeld, Ph.D.
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Attorney of Record



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PATENT TRADEMARK OFFICE

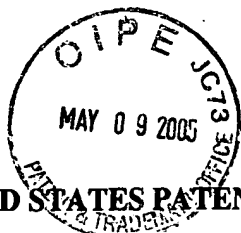
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Docket No. CAT/34-SCRO-CCP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Michael C. SCROGGIE et al.

GAU: 3623

SERIAL NO: 09/505,632

EXAMINER ROBINSON-BOYCE

FILED: February 16, 2000

FOR: SYSTEM AND METHOD FOR DISTRIBUTING INFORMATION THROUGH COOPERATIVE
COMMUNICATION NETWORK SITES

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ASSISTANT COMMISSIONER FOR PATENTS
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SIR:

Applicants hereby appeal to the Board of Appeals from the final office action dated _____ and further in view of the amendment after final filed on _____.

The items checked below are appropriate:

☐ A Petition for Extension of Time Under 37 C.F.R. §1.136 was filed for _____ months.

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☐ An Appeal Brief being filed herewith.

☐ A Petition for Extension of Time for filing the Notice of Appeal is attached.

☐ Applicant claims small entity status. See 37 C.F.R. §1.27.

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☒ 37 C.F.R. §1.17(c) Appeal Brief fee is enclosed.

Total Appeal fees enclosed: \$660.00.

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Respectfully Submitted,



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Printed: June 30, 2004 (12:28pm)

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NEIFELD DOCKET NO: CAT/34-SCRO-CCP
PRIOR ATTORNEY DOCKET NO: 7791-0103-25XCONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 5917

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/505,632

FILING DATE: February 16, 2000

GROUP ART UNIT: 3623

EXAMINER: ROBINSON-BOYCE, A.

TITLE: System and Method for Distributing Information Through Cooperative Communication
Network Sites

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ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

37 CFR 1.192 APPEAL BRIEF

Sir:

In response to the final office action mailed April 6, 2004, the applicants appeal.

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I. 37 CFR 1.192(a)

This brief is filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the applicants will rely to maintain the appeal.

II. 37 CFR 1.192(b)

The filing is timely. Accordingly, this subsection is not relevant.

III. 37 CFR 1.192(c)

A. 37 CFR 1.192(c)(1) Real Party in Interest

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. 37 CFR 1.192(c)(2) Related Appeals and Interferences

An appeal is pending in the following related application:

US Application No: 08/873,974, filed June 12, 1997 (Neifeld Ref: CAT/34-SCRO-US). The applicants filed an appeal brief December 23, 2002. The examiner's answer to the appeal brief filed December 23, 2002 was mailed March 11, 2003. The applicants filed a reply brief April 22, 2003. The Board of Patent Appeals and Interferences assigned Appeal No: 2004-1267 on April 5, 2004.

C. 37 CFR 1.192(c)(3) Status of Claims

Claims 24-31, 36-43 and 48-51 are pending, rejected, and under appeal. Claims 32-35 and 44-47 have been canceled.

D. 37 CFR 1.192(c)(4) Status of Amendments

An amendment to claims 50 and 51 correcting only a grammatical error has not been entered, and is being filed with this brief.

E. 37 CFR 1.192(c)(5) Summary of the Invention

The present invention is directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site of the manufacturer over the Internet to a remote Web site; in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one

manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address. See Claims 24, 36 and 48.

The method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site further includes transmitting a link to a Web site of the retailer. See Claims 25 and 37.

The method and system as defined in Claims 24 and 36, further includes the step of determining the at least one manufacturer's incentive and the at least one name and address of a retailer by querying, using the region data, a database from a server of the remote Web site. See Claims 26 and 38.

The method and system as defined in Claims 24 and 36, further includes the steps of transmitting from the consumer computer to the Web site of the manufacturer selection data indicating selection of the at least one manufacturer incentive; transmitting from the Web site of the manufacturer to the remote site the selection data; transmitting from the remote site to the Web site of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to the consumer computer the details. See Claims 27 and 39.

The present invention is further directed to a computer network implemented method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer; in response to receipt of the request at the Web site of the retailer, transmitting the request from the Web site of the retailer over the Internet to a remote Web site; in response to receipt of the request at the remote site, transmitting from the remote site over the Internet to the Web site of the retailer a list of manufacturer incentives; and in response to receipt of the manufacturers incentives at the Web site of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives. See Claims 28, 40 and 49.

The method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from the Web site of the retailer over the Internet to the remote Web site in association with the request; and determining manufacturer's incentives to transmit

from the remote Web site to the Web site of the retailer based upon the user identification. See Claims 29 and 41.

The method and system as defined in Claims 28 and 40, further includes the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data. See Claims 30 and 42.

The method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See Claims 31 and 43.

The invention of claims 50 and 51 are a system and a method for performing transactions involving multiple separate entities, including means for transmitting a list of manufacturer incentives from: the consumer to a retailer website, the retailer website to a remote website, and the remote website to the retailer website (page 3 line 27 through page 4 line 5).

In contrast, conventional systems and methods do not disclose nor suggest the abovenoted features of the claimed invention. In view of problems inherent with conventional systems and methods, the applicants have discovered an improved computer network implemented method, system, and computer program product, as described above.

F. 37 CFR 1.192(c)(6) Issues

Whether the rejections of claims 50 and 51 under the second paragraph of 35 USC 112 are improper and should be reversed.

Whether the rejections of claims 28, 40, 50, and 51 under 35 USC 102(e) based upon Sloane (US Patent 5,918,211) [hereinafter "Sloane"] are improper and should be reversed.

Whether the rejections of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 under 35 USC 103(a) based upon Sloane and further in view of Hoffman et al. (US Patent 6,012, 039) [hereinafter "Hoffman"] are improper and should be reversed.

Whether the rejections of claims 26, 30, 31, 38, 42, and 43 under 35 USC 103(a) based upon Sloane, Hoffman, and Smolen (US Patent 5,915,243) [hereinafter "Smolen"] are improper and should be reversed.

G. 37 CFR 1.192(c)(7) Grouping of Claims

Group 1 consists of claims 28 and 40. Group 3 consists of claims 24, 36, 48, and 49. Group 5 consists of claims 25 and 37. Group 6 consists of claims 27 and 39. Group 7 consists

of claims 29 and 41. Group 8 consists of claims 26 and 38. Group 9 consists of claims 30 and 42. Group 10 consists of claims 31 and 43. Group 11 consists of claims 50 and 51.

H. 37 CFR 1.192(c)(8) Argument

1. 37 CFR 1.192(c)(8)(ii) - Second Paragraph 35 USC 112

a. The Rejections Under 35 USC 112 of Claims 50 and 51

1. The Examiner's Argument

In support of the rejections of claims 50 and 51 under 35 USC 112, second paragraph, the examiner stated that:

Claims 50 and 51 recites [sic] the limitation "transmission from the a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "mean for transmitting from the a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required. [Office action mailed April 6, 2004 page 2 lines 18-24.]

2. The Applicants' Response

In reply, the applicants disagree for several reasons.

First, there is almost ipsus verbis antecedent basis support for the subject claim recitations in the specification, and the subject claim recitations are clearly supported by the specification's recitations. See page 3 lines 23-26 and page 11 lines 1-4.

Page 3 lines 23-26 of the specification states that:

The next steps of the method are receiving offer selection data from the consumer through the manufacturer network site, and either transmitting details of the selected offers to the manufacturer network site for use by the consumer, or linking the consumer directly to a selected retailer network site to view the available offers.

Page 11 lines 1-4 of the specification states that:

FIG. 5 shows how manufacturers input update data to the manufacturer offer database 16. In one approach, the manufacturer supplies the data on input

forms 90, which are entered at the SMO site 14, as indicated at 92, and transmitted to the databases 16 and 20 by means of an update program 94 executed at the SMO site.

These two recitations clearly disclose that there is a transmission (and a means for transmission) from the retailer website to a remote website; and a transmission (and a means for transmission) from the retailer website to a remote website. Moreover, there is sufficient indication as to what is being transmitted, namely, details of the selected offers, as well as data that is input by manufacturers and used to update the manufacturer offer database.

Second, in drafting claims 50 and 51, the applicant presented a method claim and a system claim commensurate in scope with and mirroring the wording in the Board of Patent Appeals and Interferences' (panel's) description of the independent claimed inventions. In the decision on appeal mailed October 27, 2003, the panel stated that:

With regard to the rejections under 35 U.S.C. 103, we will not sustain these rejections because each of the independent claims 24, 36, 48, and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from the a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer web site transmits to the consumer a list of these incentives.

[Decision on appeal page 9 lines 3-10.]

Since claims 50 and 51 are essentially identical in scope to the panel's description of applicant's claimed invention, they are allowable for the same reasons applying to appealed claims 24-31, 36-43, and 48-49.¹

Third, the examiner's rejections for lack of antecedent basis misapplies the law because anyone reading the claims would know what they defined. The applicants submit herewith an amendment correcting the grammatical error in these claims, mooted the antecedent basis issue.

¹ A copy of the decision on appeal mailed October 27, 2003 is Attachment 1.

For all of the foregoing reasons, the rejections of claims 50 and 51 as indefinite are improper and therefore should be reversed.

2. 37 CFR 1.192(c)(8)(iii) - 35 USC 102

a. The Rejections Under 35 USC 102(e) of Claims 28 and 40 as Being Anticipated by Sloane

1. The Examiner's Argument

In support of the rejections under 35 USC 102(e) of claims 28 and 40 as being anticipated by Sloane, the examiner stated that:

Claims 28, 40, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 40, Sloane discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 7, lines 13-22);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said

consumer computer said list of manufacturers incentives, (Col. 8, lines 3-7).

[Office action mailed April 6, 2004 page 3 line 12 through page 4 line 11.]

**2. The Board of Patent Appeals and Interferences
Reversed the Rejections Under 35 USC 102(e) of Claims
28 and 40 as Being Anticipated by Sloane, so the
Repeated Rejection of these Claims is Barred by 37
CFR 1.197(a)**

In the decision on appeal mailed October 27, 2003, the panel reversed the examiner's rejections under 35 USC 102(e) of Claims 28, 40 as being anticipated by Sloane. In its opinion, the panel stated that:

Turning, initially, to the rejection under 35 U.S.C. § 102(e), an anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990) .

It is the examiner's position that Sloane discloses, at column 7, lines 5-10, the transmission from a consumer computer of a request for manufacturer incentives; at column 7, lines 13-22, the transmission of region data from the website of a manufacturer in response to the request for- manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacture incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer

computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e). [Decision on appeal page 3 line 15 through page 6 line 11.] 37 CFR 1.197(a) entitled "Action following decision," states that:

After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal

or other review, for such further action by appellant or by the examiner, as the condition of the application may require, **to carry into effect the decision.**

[Emphasis supplied.]

In conformity with this panel's holding, the examiner's rejections of claims 28 and 40 as being anticipated by Sloane are improper, as they are precluded by 37 CFR 1.197(a) and res judicata. Therefore, the examiner should reverse the rejections of claims 28 and 40.

3. The Rejections Under 35 USC 102(e) of Claims 50 and 51 as Being Anticipated by Sloane

(a) The Examiner's Argument

In support of the rejections of claims 50 and 51 under 35 USC 102(e) as being anticipated by Sloane, the examiner stated that:

Claims [50 and 51] are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211). [Office action page 3 lines 12-13.]

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website [sic], (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26). [Office action page 4 lines 12-25.]

**(b) The Rejections Under 35 USC 102(e) of Claims
50 and 51 as Being Anticipated by Sloane are
Barred by Issue Preclusion**

In its simplest construct, res judicata precludes the relitigation of a claim, or cause of action, or any possible defense to the cause of action which is ended by a judgment of the court. See Restatement (Second) of Judgments, § § 18, 19 (1982). This aspect of res judicata, known in modern parlance as "claim preclusion", applies whether the judgment of the court is rendered after trial and imposed by the court or the judgment is entered upon the consent of the parties. See, e.g., *Lawlor v. National Screen Serv. Corp.*, 349 U.S. 322, 327 (1955); *Kaspar Wire Works, Inc. v. Leco Eng'g and Mach., Inc.*, 575 F.2d 530, 538-39, 198 USPQ 513, 518-19 (5th Cir. 1978); 18 C. Wright, A. Miller, and E. Cooper, *Federal Practice and Procedure*, § 4443 at 385 (1981) (consent judgments ordinarily support claim preclusion but not issue preclusion). [*Foster v. Hallco Manufacturing Co. Inc.*, ___ F.3d ___, ___, 20 USPQ2d 1241, 1246 (Fed. Cir. 1991).]

Section 27 of the Restatement states the general rule of issue preclusion:

When an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.

Restatement (Second) of Judgments, § 27. A rationale for the rule of issue preclusion is that once a legal or factual issue has been settled by the court after a trial in which it was fully and fairly litigated that issue should enjoy repose. See *Southern Pacific R.R.*, 168 U.S. at 48-49. Such litigated issues may not be relitigated even in an action on a different claim between the parties. See Restatement (Second) of Judgments, § 27 comment (e) & note at 267-68; *Young Eng'rs*, 721 F.2d at 1316, 219 USPQ at 1152; *Jackson Jordan*, 747 F.2d at 1575-76, 224 USPQ at 7; *Eilrich v. Ramas*, 839 F.2d 630, 632 (9th Cir. 1988); *Garrett v. City and County of San Francisco*, 818 F.2d 1515, 1520 (9th Cir. 1987). Where a judgment between parties is entered by consent prior to trial on any issue, no issue may be said to have been fully, fairly or actually litigated. See Restatement, § 27 comment (e) at 257; *Kaspar Wire Works*, 575 F.2d at 537, 198 USPQ at 518. Thus, the general rule that issue preclusion does not arise from a consent

judgment would allow Foster's challenge to validity on a different claim inasmuch as no issue was actually tried and disposed of by decision of the court in Foster I. [Foster v. Hallco Manufacturing Co. Inc., ___ F.3d ___, ___, 20 USPQ2d 1241, 1250-51 (Fed. Cir. 1991).]

Based on the reversal of the rejections under 35 USC 103 of independent claims 24, 36, 48, and 49 as being obvious over Sloane in the decision on appeal mailed October 27, 2003, the applicants added claims 50 and 51, which are commensurate in scope with and mirror the wording in the panel's description of the independent claimed inventions.

Specifically, in reversing the rejections of claims 24, 36, 48, and 49, the panel stated that:

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. **As explained supra, Sloane is devoid of any such teaching.** Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. 103. [Decision on appeal page 9 lines 3-18; emphasis supplied.]

Since claims 50 and 51 are essentially identical in scope to the panel's description of applicants' claimed invention, they raise the issue decided in the appeal, and they are allowable over the art cited by the examiner for the same reasons applying to the appealed claims. The issue being whether Sloane discloses claims 50 and 51's consumer website, retailer website, and remote website transmissions. Therefore, no new issues were raised with the addition of claims 50 and 51; and therefore, the examiner's assertion that claims 50 and 51 are anticipated by Sloane is barred by issue preclusion.

Accordingly, the rejections under 35 USC 102(e) of claims 50 and 51 as being anticipated by Sloane are improper and therefore should be reversed for issue preclusion.

**(c) In any Case, Sloane does not Anticipate Claims
50 and 51**

The examiner asserts that claims 50 and 51 are rejected under 35 USC 102(e) as being anticipated by Sloane, stating that:

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website, (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26). [Office action page 4 lines 12-25.]

In reply, the applicants submit that the examiner's assertion is incorrect. Sloane fails to disclose what is recited in claims 50 and 51.

Sloane column 7 lines 5-10 does not disclose a retailer website and it does not disclose transmission between a consumer and a retailer website. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 13-22 does not disclose either a remote website or a retailer website and it does not disclose transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 22-26 does not disclose either a remote website or a retailer website and it does not disclose transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 5-10 does not disclose a retailer website and it does not disclose means for transmission between a consumer and a retailer website. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 13-22 does not disclose either a retailer website or a remote website and it does not disclose means for transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

Sloane column 7 lines 22-26 does not disclose either a remote website or a retailer website and it does not disclose means for transmission therebetween. Accordingly, the applicants submit that claims 50 and 51 are not anticipated under 35 USC 102(e) by Sloane.

3. 37 CFR 1.192(c)(8)(iv) - Rejections Under 35 USC 103(a)

a. The Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloane and Further in View of Hoffman

1. The Examiner's Argument

In support of the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over Sloane and further in view of Hoffman, the examiner stated that:

Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:
transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting ... in response to said request for manufacturer incentives, transmitting region data ... means for, in response to said request ... in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data ... (Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:
transmitting ... at least one name.../means for transmitting ... at least one

name ... (Col. 11, lines 1-9 read with Col. 13, lines 5-10).

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link ... /wherein said means for transmitting from said remote site said list further comprises means for transmitting a link ... (Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting ... (Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffinan, et al discloses: transmitting from said Web site of said manufacturer.../means for transmitting from said Web site ... (Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details...lmeans for transmitting from said remote site ... (Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer ... (Col. 6, lines 62-63).

It would have been obvious to one of ordinary skill In the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification .../means for transmitting a user identification ... determining manufacturer's incentives ...means for determining manufacturer's incentives ... (Col. 9, lines 52-58, Claim 12, Claim 15). [Office action mailed April 6, 2004 page 5 line 11 through page 7 line 11.]

2. The Applicants' Response

(a) The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being Obvious Over Sloan and Further in View of Hoffman

In its opinion, the panel addressed the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over Sloane and further in view of Hoffman and stated that:

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, **Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. 103.** [Decision on appeal page 9 lines 3-18; emphasis supplied.]

Based on the Board's authority enumerated in 37 CFR 1.197(a), cited infra, the rejections under 35 USC 103(a) of claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as being obvious over

Sloane and further in view of Hoffman are improper, as they are precluded by 37 CFR 1.197(a), claim preclusion, and res judicata, and therefore should be reversed.

(b) **The Rejections Under 35 USC 103(a) of Claims
24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 as Being
Obvious Over Sloan and Further in View of
Hoffman are Untenable and Should be Reversed**

Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman. That rejection is untenable and should be reversed.

i. **Hoffman is not Prior Art**

In reply, the applicant submits, first of all, that Hoffman is NOT 102(e) prior art. Hoffman is USP 6,012,039 to Hoffman, which issued from application 09/244,784 filed 2/5/1999.

This application has a U.S. 35 USC 120 priority filing date of 6/12/1997 via priority claim to application 08/873,974.

Accordingly, USP 6,012,039 to Hoffman is not prima facie prior art.

Moreover, Hoffman's disclosure upon which the examiner relies does not exist in its claimed priority application. Hoffman claims priority (as an alleged "continuation" from application 08/705,399 filed: 8/29/1966. 08/705,399 issued as USP 5,870,723. However, **the disclosure in Hoffman relied upon by the examiner does not exist in USP 5,870,723.** Specifically, the examiner relies upon column 11 lines 1-9 in Hoffman, which read as follows:

In a preferred embodiment, the transaction processor 26 receives the identification results from the identification module. Once the recipient and their rewards accounts, as well as the particular rule module that would govern this transaction is located, using the identity of the recipient, the transaction processor locates the recipient's Recipient Electronic Registry (RER). Using the issuer identification data (Issuer ID 64) contained in the transaction request message 60, the transaction processor identifies the issuer's default rule module 62 which contains the instructions for debit or credit of the recipients rewards account. Alternatively, the instruction for debit and credit and various other restrictions on

credit or debit of a recipient's reward account is contained in the transaction request message itself 60. Should the transaction request message 60 contain an electronic pointer 68, the default rule module is then overridden and another rule module (rule module P1, P2, etc.) particular to the reward transaction is invoked.

That passage does not exist in USP 5,870,723.

The examiner also relies upon column 13 lines 5-10 in Hoffman. This passage reads:

Typically, a rewards issuer registers issuer identification data (Issuer ID) with the electronic identifier. The Issuer ID comprises any of the following: digital certificate, hardware identification, web site, trade name, financial account number, telephone number, employer identification number, and the like.

That passage does not exist in USP 5,870,723.

In summary, there is no evidence to support the conclusion that the disclosure in Hoffman at column 11 lines 1-9 or column 13 lines 5-10 is prior art. In fact, the applicant has just shown that evidence of record (USP 5,870,723 was made of record prior to the appeal and its lack of prior art status was argued in the prior brief; the Board's failure to recognize that argument constitutes facts overlooked) and conclusively proved that **Hoffman is not prior art**. For this additional reason, the rejections are substantively improper.

ii. **The Claims Distinguish, in any Case**

Nonetheless, the applicants submit that the claimed invention, as recited in Claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49, is patentably distinguishable over Sloane, alone or in combination with Hoffman, as is further argued below.

The present invention, as recited in Claims 24, 36, 48, and 49, is directed to the method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site 10 of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site 10 of the manufacturer over the Internet to a remote Web site 14; in response to receipt of region data at the manufacturer's Web site 10, transmitting from the remote Web site 14 to the Web site 10 of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site 10 of the manufacturer over the Internet to the consumer computer the at least

one manufacturer incentive and the at least one name and address. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest all of the noted features of the claimed invention.

The examiner asserts at page 5 line 14 through page 6 line 16 of the office action mailed April 6, 2004 that Sloane teaches all of the above-noted features except "in response to receipt of region data at the manufacturer's Web site, transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address." However, the applicants submit that although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200, as previously described, Sloane fails to disclose or suggest the noted features of the claimed invention. See Figures 3a and 3b and the discussion in Sloane thereof. The applicants submit that Hoffman fails to cure the noted deficiencies with Sloane and that Claims 24, 36, 48, and 49 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

Further, as acknowledged by the examiner at page 5 lines 23-24 of the office action mailed April 6, 2004, Sloane fails to teach or suggest "transmitting from the remote Web site to the Web site of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer, and transmitting from the Web site of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address." The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 11, lines 1-9 and column 13, lines 5-10 of Hoffman.

However, the applicants submit that Hoffman merely discloses a secure incentive distribution system and method between a party identification apparatus (PIA) 1 and a data processing center (DPC) 22 via a communications network 10, such as the Internet and fail to teach or suggest the noted feature of the claimed invention. See Figs. 1 and 2, and column 6, line 28 to column 8, line 41 of Hoffman.

In the above respect, the applicants submit that in the invention of Hoffman there is no need to send a name and address of a retailer since Hoffman teaches that the identification of

both parties during an incentives distribution transaction are automatically identified by decrypting provided encryption codes. See column 8, lines 42-52 of Hoffman. Accordingly, the applicants submit that, contrary to the assertion by the examiner, Hoffman fails to teach or suggest the noted feature of the claimed invention and that Claims 24, 36, and 48 are not obvious under 35 U.S.C. § 103(a) over, Sloane, alone or in combination with Hoffman.

The present invention, as recited in Claims 25 and 37, is directed to the method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site 14 further includes transmitting a link to a Web site 12 of the retailer. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 6, lines 7-10 of the office action mailed April 6, 2004, Sloane fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 14, lines 64-67 of Hoffman.

However, the applicants submit that Hoffman merely discloses a reward recipient locating a Web site of a rewards issuer, but fails to teach or suggest transmitting from a **remote site** a link to a Web site of a retailer, as in the claimed invention (emphasis added). See column 14, lines 64-67 of Hoffman. Accordingly, the applicants submit that Claims 25 and 37 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman.

The present invention, as recited in Claims 27 and 39, is directed to the method and system as defined in Claims 24 and 36, further includes the steps of transmitting from a consumer computer to a Web site 10 of a manufacturer selection data indicating selection of at least one manufacturer incentive; transmitting from the Web site 10 of the manufacturer to a remote site 14 the selection data; transmitting from the remote site 14 to the Web site 10 of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site 10 of the manufacturer to the consumer computer the details. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

The applicants submit that, contrary to the assertion by the examiner at page 6 lines 14-16 of the office action mailed April 6, 2004, although Sloane discloses processing incentives

between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest transmitting from a consumer computer to a Web site of a manufacturer selection data indicating selection of at least one manufacturer incentive, as in the claimed invention. The applicants submit that Hoffman fails to cure the noted deficiencies with Sloane and that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

In addition, as acknowledged by the examiner, at page 6, lines 7-14 of the office action mailed April 6, 2004, Sloane fails to teach or suggest transmitting from a Web site of the manufacturer to a remote site selection data; transmitting from the remote site to the Web site of the manufacturer details of selected at least one manufacturer incentive; and transmitting from the Web site of the manufacturer to a consumer computer the details, as in the claimed invention. The examiner attempts to cure such deficiencies in Sloane by applying disclosure from column 6, lines 46-63 of Hoffman.

However, the applicants submit that Hoffman merely discloses a personal identification apparatus (PIA) 1 capable of performing various secure reward processing functions with a data processing device (DPC) 22, but fails to teach or suggest the noted features of the claimed invention. See column 6, lines 27-65 of Hoffman. Accordingly, the applicants submit that Claims 27 and 39 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman.

The present invention, as recited in Claims 29 and 41, is directed to the method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from a Web site 12 of a retailer over the Internet to a remote Web site 14 in association with a request; and determining manufacturer's incentives to transmit from the remote Web site 14 to the Web site 12 of the retailer based upon the user identification. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention.

The applicants submit that, contrary to the assertion by the examiner at page 7, lines 7-11 of the office action mailed April 6, 2004, although Sloane discloses processing incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 over a communication network 200 as previously discussed, Sloane fails to disclose or suggest the noted features of the claimed invention. The applicants submit that Hoffman fails to cure the

noted deficiencies with Sloane and that Claims 29 and 41 are not obvious under 35 U.S.C. §103(a) over Sloane, alone or in combination with Hoffman.

Based on the above discussion, the applicants submit that claims 24, 25, 27, 29, 36, 37, 39, 41, 48, and 49 are patentably distinguishable under 35 USC 103 over the applied references and therefore should be reversed.

b. The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloane and Further in View of Hoffman and Smolen

1. The Examiner's Argument

In support of the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 based upon Sloane and further in view of Hoffman and Smolen, the examiner stated that:

Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining..

.transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting ... (Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data ... (Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It, would have been obvious to one of ordinary skill in the art for the

region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer. [Office action mailed April 6, 2004 page 7 line 12 through page 8 line 12.]

2. The Applicants' Response

(a) The Board of Patent Appeals Reversed the Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen

Based on the arguments contained in III. H. 3. a. 2., *infra*, the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 based upon Sloane and further in view of Hoffman and Smolen are improper, as they are precluded by 37 CFR 1.197(a), claim preclusion, *res judicata*, and therefore should be reversed.

Based on the arguments regarding Hoffman contained in III. H. 3. a. 2. b. i., *infra*, there is no *prima facie* case for the rejections under 35 USC 103(a) of claims 26, 30, 31, 38, 42, and 43 as being obvious over Sloan and further in view of Hoffman and Smolen because Hoffman is not prior art.

(b) The Rejections Under 35 USC 103(a) of Claims 26, 30, 31, 38, 42, and 43 as Being Obvious Over Sloan and Further in View of Hoffman and Smolen are Untenable and Should be Reversed

Claims 26, 30, 31, 38, 42, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane in view of Hoffman and further in view of Smolen. In any case, the rejections are untenable, and should be reversed for the following reason.

The present invention, as recited in Claims 26 and 38, is directed to the method and system as defined in Claims 24 and 36, further includes the step of determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 from a server 14 of a remote Web site. See, e.g., Figs. 1 and 2 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in

combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 7, lines 15-21 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloane and Hoffman by applying disclosure from column 2, line 66 to column 3, line 9 of Sloan.

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection, but fails to teach or suggest determining at least one manufacturer's incentive and at least one **name and address of a retailer** by querying, using region data, a database from a server of a remote Web site, as in the claimed invention (emphasis added). See column 2, line 66 to column 3, line 9 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 26 and 38 are not obvious under 35 U.S.C. §103(a) over Sloane in view of Hoffman and further in view of Smolen.

The present invention, as recited in Claims 30 and 42, is directed to the method and system as defined in Claims 28 and 40, further includes the step of transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 7 lines 15-21 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloan and Hoffman by applying disclosure from column 2, line 66 to column 3, line 9 of Smolen

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 30 and 42 are

not obvious under 35 U.S.C. § 103(a) over Sloane in view of Hoffman and further in view of Smolen.

The present invention, as recited in Claims 31 and 43, is directed to the method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention.

As acknowledged by the examiner, at page 8, lines 5-9 of the office action mailed April 6, 2004, Sloane, in combination with Hoffman, fails to teach or suggest the noted features of the claimed invention. The examiner attempts to cure such deficiencies in Sloan and Hoffman by applying disclosure from column 4, line 64-67 of Smolen.

However, the applicants submit that Smolen merely discloses providing promotions between a consumer system 100 and a promotions processing facility 130 via a communications channel, such as dial-up connection and generating a user profile including demographic information, such a phone number of the consumer, but fails to teach or suggest the noted feature of the claimed invention. See column 2, line 66 to column 3, line 9, column 4, lines 55-67 and column 7, lines 12-24 of Smolen. Accordingly, the applicants submit that Claims 31 and 43 are not obvious under 35 U.S.C. § 103(a) over Sloane in view of Hoffman and further in view of Smolen

Based on the above discussion, the applicants submit that claims 26, 30, 31, 38, 42, and 43 are patentably distinguishable under 35 USC 103 over the applied references and therefore should be reversed.

4. 37 CFR 1.192(c)(8)(v) - Other Rejections Under 35 USC 103(a)

a. Objections to Claims 50 and 51

1. The Examiner's Argument

In objecting to the informalities in claims 50 and 51, the examiner stated that:

Claims 50 and 51 are objected to because of the following informalities: in the 3rd line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

[Office action mailed April 6, 2004 page 2 lines 11-13.]

2. The Applicants' Response

In reply, the applicants submit herewith an amendment to claim 50 changing "the a consumer" to "the consumer", and to claim 51 changing "the a consumer" to "the consumer".

IV. Groupings of Claims - Why Rejections of Each Group Should be Reversed

A. Group 1 - Claims 28 and 40

The present invention, as recited in Claims 28 and 40, is directed to a computer network implemented method and system including transmitting from a consumer computer over the Internet to a Web site 12 of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer; in response to receipt of the request at the Web site 12 of the retailer, transmitting the request from the Web site 12 of the retailer over the Internet to a remote Web site 14; in response to receipt of the request at the remote site 14, transmitting from the remote site 14 over the Internet to the Web site 12 of the retailer a list of manufacturer incentives; and in response to receipt of the manufacturers incentives at the Web site 12 of the retailer, transmitting over the Internet to the consumer computer the list of manufacturers incentives. The applicants submit that Sloane fails to disclose or suggest the above-noted features of the claimed invention.

B. Group 3 - Claims 24, 36, 48, and 49

The present invention, as recited in Claims 24, 36, 48, and 49, is directed to the method, system, and computer program product including transmitting from a consumer computer over the Internet to a Web site 10 of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by the manufacturer; in response to the request for manufacturer incentives, transmitting region data from the Web site 10 of the manufacturer over the Internet to a remote Web site 14; in response to receipt of region data at the manufacturer's Web site 10, transmitting from the remote Web site 14 to the Web site 10 of the manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and transmitting from the Web site 10 of the manufacturer over the Internet to the consumer computer the at least one manufacturer incentive and the at least one name and address. The applicants submit that Sloane, alone or in combination with Hoffman et al, fails to disclose or suggest all of the noted features of the claimed invention. In addition, Hoffman is not prior art.

C. Group 5 - Claims 25 and 37

The present invention, as recited in Claims 25 and 37, is directed to the method and system as defined in Claims 24 and 36, wherein the step of transmitting from the remote site 14 further includes transmitting a link to a Web site 12 of the retailer. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

D. Group 6 - Claims 27 and 39

The present invention, as recited in Claims 27 and 39, is directed to the method and system as defined in Claims 24 and 36, further includes the steps of transmitting from a consumer computer to a Web site 10 of a manufacturer selection data indicating selection of at least one manufacturer incentive; transmitting from the Web site 10 of the manufacturer to a remote site 14 the selection data; transmitting from the remote site 14 to the Web site 10 of the manufacturer details of the selected at least one manufacturer incentive; and transmitting from the Web site 10 of the manufacturer to the consumer computer the details. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

E. Group 7 - Claims 29 and 41

The present invention, as recited in Claims 29 and 41, is directed to the method and system as defined in Claims 28 and 40, further includes the steps of transmitting a user identification from a Web site 12 of a retailer over the Internet to a remote Web site 14 in association with a request; and determining manufacturer's incentives to transmit from the remote Web site 14 to the Web site 12 of the retailer based upon the user identification. The applicants submit that Sloane, alone or in combination with Hoffman, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

F. Group 8 - Claims 26 and 38

The present invention, as recited in Claims 26 and 38, is directed to the method and system as defined in Claims 24 and 36, further includes the step of determining at least one manufacturer's incentive and at least one name and address of a retailer by querying, using region data, a database 16 from a server 14 of a remote Web site. See, e.g., Figs. 1 and 2 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in

combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

G. Group 9 - Claims 30 and 42

The present invention, as recited in Claims 30 and 42, is directed to the method and system as defined in Claims 28 and 40, further includes the step of transmitting from a consumer computer over the Internet to a Web site 12 of a retailer region data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

H. Group 10 - Claims 31 and 43

The present invention, as recited in Claims 31 and 43, is directed to the method and system as defined in Claims 30 and 42, wherein the region data is postal code data. See, e.g., Figs. 1 and 3 and the discussion in the applicants' disclosure thereof. The applicants submit that Sloane, alone or in combination with Hoffman and Smolen, fails to disclose or suggest the noted features of the claimed invention. In addition, Hoffman is not prior art.

I. Group 11 - Claims 50 and 51

The rejections of claims 50 and 51 should be reversed because the examiner has not shown that Sloane discloses a system or method including transmission from the consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives.

V. 37 CFR 1.192(d) - Non-compliant Brief

This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

31518

PATENT TRADEMARK OFFICE

7/2/04
Date

Respectfully Submitted,


Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Printed: July 2, 2004 (10:51am)

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VI. Appendix - Claims 24-51 Involved in the Appeal

24. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

25. (Previously presented) The method according to claim 24, wherein said step of transmitting from said remote site further comprises transmitting a link to a Web site of said retailer.

26. (Previously presented) The method according to claim 24, further comprising the step of determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

27. (Previously presented) The method according to claim 24, further comprising the steps of:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

transmitting from said Web site of said manufacturer to said remote site said selection data;

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

transmitting from said Web site of said manufacturer to said consumer computer said details.

28. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. (Previously presented) The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. (Previously presented) The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. (Previously presented) The method according to claim 30, wherein said region data is postal code data.

32-35. (Canceled)

36. (Previously presented) A computer network implemented system, comprising:
means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site,

transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. (Previously presented) The system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. (Previously presented) The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. (Previously presented) The system according to claim 36, further comprising:
means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;
means for transmitting from said Web site of said manufacturer to said remote site said selection data;
means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and
means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. (Previously presented) A computer network implemented system, comprising:
means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives;

and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. (Previously presented) The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

42. (Previously presented) The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. (Previously presented) The system according to claim 42, wherein said region data is postal code data.

44-47. (Canceled)

48. (Previously presented) A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. (Previously presented) A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the

Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

50. (Previously presented) A computer implemented method comprising performing transactions involving multiple separate entities, including
transmission from the a consumer to a retailer website,
transmission from the retailer website to a remote website, and
transmission from the remote website to the retailer website, of a list of manufacturer incentives.

51. (Previously presented) A system comprising structure for performing transactions involving multiple separate entities, including:

mean for transmitting from the a consumer to a retailer website,
means for transmitting from the retailer website to a remote website, and
means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives.

Printed: July 2, 2004 (10:51am)

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11/13/03
CS

Attachment 1

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

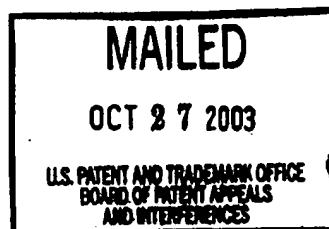
REVIEW DATE: 11/27/03

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2002-0329
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

APDEC-CAT34SCROCCP-031103 CS

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

Smolen	5,915,243	Jun. 22, 1999 (filed Aug. 29, 1996)
Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)

Appeal No. 2002-0329
Application No. 09/505,632

Hoffman et al. (Hoffman) 6,012,039 Jan. 4, 2000
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Sloane and Hoffman with regard to claims 24, 25, 27, 29, 36, 37, 39, 41, 48 and 49, adding Smolen to this combination with regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

Turning, initially, to the rejection under 35 U.S.C. § 102(e), an anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at column 7, lines 5-10, the transmission from a consumer computer of a request for manufacturer incentives; at column 7, lines 13-

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

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Application No. 09/505,632

clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

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Application No. 09/505,632

The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

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Application No. 09/505,632

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

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Application No. 09/505,632

corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

Appeal No. 2002-0329
Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

Appeal No. 2002-0329
Application No. 09/505,632

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

**BOARD OF PATENT
APPEALS AND
INTERFERENCES**

JOSEPH F. RUGGIERO
Administrative Patent Judge

EK/RWK

Appeal No. 2002-0329
Application No. 09/505,632

NEIFIELD IP LAW, P.C.
2001 JEFFERSON DAVIS HIGHWAY
SUITE 1001
ARLINGTON, VA 22202

Docket No. CAT/34-SCRO-CCP

IN RE APPLICATION OF: Michael C. Scroggie et al.

SERIAL NO: 09/505,632

FILED: 2/16/2000

FOR: System and Method for Distributing Information Through Cooperative Communication Network Sites

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313



RECEIVED

MAY 16 2005

Technology Center 2100

**AMENDMENT COVER LETTER
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☐ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.
- ☒ Additional documents filed herewith: PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

The Fee has been calculated as shown below:

	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATION S
TOTAL	51	MINUS	51	0	× \$18 =	\$0.00
INDEPENDENT	8	MINUS	8	0	× \$86 =	\$0.00
		<input type="checkbox"/>	MULTIPLE DEPENDENT CLAIMS			+ \$290 = \$0.00
			TOTAL OF ABOVE CALCULATIONS			\$0.00
		<input type="checkbox"/>	Reduction by 50% for filing by Small Entity			\$0.00
		<input type="checkbox"/>	Recordation of Assignment			+ \$40 = \$0.00
		<input type="checkbox"/>	Petition for Extension of Time: 1 Month			+ \$110 = \$0.00
		<input type="checkbox"/>	2 Months			+ \$420 = \$0.00
		<input type="checkbox"/>	3 Months			+ \$950 = \$0.00
		<input type="checkbox"/>	4 Months			+ \$1,480 = \$0.00
		<input type="checkbox"/>	Terminal Disclaimer			+ \$130 = \$0.00
		<input type="checkbox"/>	Information Disclosure Statement Prior to Final			+ \$180 = \$0.00
			TOTAL			\$0.00

☒ A check including the amount of **\$0.00** is attached.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE

Neifeld IP Law, PC
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

Date

7/2/04

Respectfully Submitted,

Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

Tel: 703-415-0012

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GROUP 3600

Printed: July 2, 2004 (11:26am)

Y:\Clients\Catalina\CAT34-SCRO\CAT34-SCRO-CCP\Drafts\AmCvrLtr_040701.wpd

Docket No. CAT/34-SCRO-CCP

IN RE APPLICATION OF: Michael C. Scroggie et al.

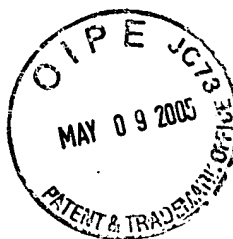
SERIAL NO: 09/505,632

FILED: 2/16/2000

FOR: System and Method for Distributing Information Through Cooperative Communication Network Sites

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313



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**AMENDMENT COVER LETTER
INCLUDING AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

SIR:

Transmitted herewith is an amendment in the above-identified application.

- ☐ No additional fee is required
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement previously submitted.
- ☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been established by a verified statement submitted herewith.

- ☒ Additional documents filed herewith: PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)

The Fee has been calculated as shown below:

	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATION S		
TOTAL	51	MINUS	51	0	× \$18 =	\$0.00		
INDEPENDENT	8	MINUS	8	0	× \$86 =	\$0.00		
		<input type="checkbox"/>	MULTIPLE DEPENDENT CLAIMS			+ \$290 =	\$0.00	
			TOTAL OF ABOVE CALCULATIONS				\$0.00	
		<input type="checkbox"/>	Reduction by 50% for filing by Small Entity				\$0.00	
		<input type="checkbox"/>	Recordation of Assignment				+ \$40 =	\$0.00
		<input type="checkbox"/>	Petition for Extension of Time: 1 Month				+ \$110 =	\$0.00
		<input type="checkbox"/>	2 Months				+ \$420 =	\$0.00
		<input type="checkbox"/>	3 Months				+ \$950 =	\$0.00
		<input type="checkbox"/>	4 Months				+ \$1,480 =	\$0.00
		<input type="checkbox"/>	Terminal Disclaimer				+ \$130 =	\$0.00
		<input type="checkbox"/>	Information Disclosure Statement Prior to Final				+ \$180 =	\$0.00
					TOTAL	\$0.00		

- ☒ A check including the amount of **\$0.00** is attached.

- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106.

31518

PATENT TRADEMARK OFFICE

Date

7/2/04

Respectfully Submitted,

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Tel: 703-415-0012

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MAY 19 2005

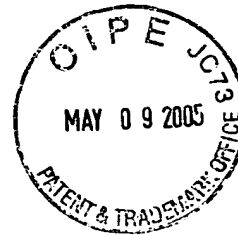
GROUP 3600

Neifeld IP Law, PC
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

Printed: July 2, 2004 (11:26am)

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NEIFELD DOCKET NO: CAT/34-SCRO-CCP
PRIOR ATTORNEY DOCKET NO: 7791-0103-25XCONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 5917

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/505,632

FILING DATE: February 16, 2000

GROUP ART UNIT: 3623

EXAMINER: ROBINSON-BOYCE, A.

TITLE: System and Method for Distributing Information Through Cooperative Communication
Network Sites

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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

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37 CFR 1.114 AMENDMENT

Sir:

In response to the final Office action mailed April 6, 2004, please amend this application
as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this
paper.

Remarks/Arguments begin on page 6 of this paper.

IN THE CLAIMS

This listing of claims replaces all prior listings.

24. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

25. (Previously presented) The method according to claim 24, wherein said step of transmitting from said remote site further comprises transmitting a link to a Web site of said retailer.

26. (Previously presented) The method according to claim 24, further comprising the step of determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

27. (Previously presented) The method according to claim 24, further comprising the steps of:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

transmitting from said Web site of said manufacturer to said remote site said selection data;

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

transmitting from said Web site of said manufacturer to said consumer computer said details.

28. (Previously presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. (Previously presented) The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. (Previously presented) The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. (Previously presented) The method according to claim 30, wherein said region data is postal code data.

32-35. (Canceled)

36. (Previously presented) A computer network implemented system, comprising:
means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. (Previously presented) The system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. (Previously presented) The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. (Previously presented) The system according to claim 36, further comprising:

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. (Previously presented) A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. (Previously presented) The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

42. (Previously presented) The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. (Previously presented) The system according to claim 42, wherein said region data is postal code data.

44-47. (Canceled)

48. (Previously presented) A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. (Previously presented) A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

50. (Currently amended) A computer implemented method comprising performing transactions involving multiple separate entities, including

transmission from ~~the~~ a consumer to a retailer website,

transmission from the retailer website to a remote website; and

transmission from the remote website to the retailer website, of a list of manufacturer incentives.

51. (Currently amended) A system comprising structure for performing transactions involving multiple separate entities, including:

means ~~mean~~ for transmitting from ~~the~~ a consumer to a retailer website,

means for transmitting from the retailer website to a remote website, and

means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives.

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

I. The Status of All Claims

Claims 24-31; 36-43; and 48-51 are pending in the application. Claims 24-31; 36-43; and 48-51 stand rejected. Claims 24, 28, 36, 40, 48, 49, 50, and 51 are the only independent claims.

II. The Rejections of Claims 50 and 51 Due to Informalities

A. Objections to Claims 50 and 51

1. The Examiner's Argument

In objecting to the informalities in claims 50 and 51, the examiner stated that:

Claims 50 and 51 are objected to because of the following informalities: in the 3rd line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

[Office action mailed April 6, 2004 page 2 lines 11-13.]

2. The Applicants' Response

In reply, the applicants amend claim 50 by changing "the a consumer" to "a consumer". The applicants amend claim 51 by changing "the a consumer" to "a consumer". The applicants amend the typographical error in claim 51 by changing "mean" to "means".

No new matter has been added.

III. Closure

Should the examiner have any questions, the examiner is urged to contact the undersigned at 703-415-0012.

7/2/04
Date

Respectfully Submitted,

Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

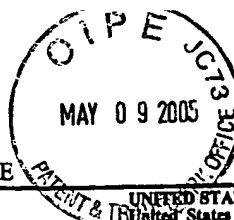
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Printed: July 2, 2004 (11:26am)

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,632 ✓	02/16/2000 ✓	Michael C. Scroggie ✓	CAT/34-SCRO-CCP ✓	5917 ✓
31518	7590	10/21/2004	EXAMINER	
NEIFELD IP LAW, PC 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			ROBINSON BOYCE, AKIBA K ✓	
			ART UNIT	PAPER NUMBER
			3623 ✓	

DATE MAILED: 10/21/2004

Reminder-Resp to OA : 12-21-04
Response Due : 1-21-05
Last Day to File : 4-21-05

Please find below and/or attached an Office communication concerning this application or proceeding.

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MAY 19 2005

GROUP 3600

445

OA-CAT34SCROCP-041022 EB

Office Action Summary**Application No.**

09/505,632

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

RECEIVED**MAY 19 2005****GROUP 3600****Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Advisory Action.

Notice of References Cited	Application/Control No. 09/505,632	Applicant(s)/Patent Under Reexamination SCROGGIE ET AL.	
	Examiner Akiba K Robinson-Boyce	Art Unit 3623	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,950,173	09-1999	Perkowski, Thomas J.	705/26
	B	US-5,918,211	06-1999	Sloane, Martin A.	705/16
	C	US-5,915,243	06-1999	Smolen, Daniel T.	705/14
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)

Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

DETAILED ACTION

Status of Claims

1. The following office action is in response to the appeal brief filed 7/2/04. Claims 50 and 51 have been amended as described in the amendment also filed 7/2/04. The finality of the previous office action has been withdrawn and the amendment filed 7/2/04 has been entered. Claims 24-31, 36-43, and 48-51 are pending in this application, and have been examined on the merits. The previous rejection has been withdrawn, and the following reflects the claims as amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 50 and 51 recites the limitation "transmission from a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "means for transmitting from a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3623

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 24, 25, 26, 28, 30, 36, 37, 38, 40, 42, 48, 48, 49, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (US Patent 5,950,173).

As per claim 28, 40, Perkowski discloses:
transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework);

in response to receipt of said request at said Web site of said retailer,
transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 15, lines 37-49, shows that when a request is made, the IPI finding mode and the UPN (i.g. UPC) search mode of the IPI finding and serving subsystem is activated through the IPI website. In this case, the IPI finding and serving subsystem is the remote system since it is associated with the operation of the Web based document server which serves Web pages to clients);

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in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the retailer website is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client], w/ Col. 11, lines 37-40, [shows that a central UPC/URL database Subsystem serves the consumer product information to retailers, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to retailers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives).

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and

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therefore works in conjunction with the UPC/URL database to serve the consumer product information to the consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives).

As per claim 24, 36, 48, 49, Perkowski discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer/means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework, in this case, both the manufacturer and retailer can be accessed at the retailer site since a three-field Netscape-style display framework is presented for interaction between the consumer and the manufacturer, and the consumer and the retailer);

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer

Art Unit: 3623

transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 11, lines 37-45, shows that consumer product information is stored to (transferred over to) the UPC/URL Database from a remote retailer or consumer, which includes the URLs specifying the location of information resources);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/means for transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/ in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives, (Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote clients, which are retailers, consumers, and manufacturers)

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address/ in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the consumer computer is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client, w/ Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, where the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers).

As per claim 25, 37, Perkowski discloses:

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wherein said step of transmitting from said remote site said list further comprises transmitting a link to a Web site of said retailer/wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 11, lines 34-45, serving URLs to retailer).

As per claims 26, 30, 38, 42, Perkowski discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site/means for determining...transmitting from the consumer computer over the Internet to the Web site of the retailer region data./means for transmitting...(Col. 22, lines 48-60, URL selection query for product data, Col. 11, lines 34-40, shows that product data includes manufacturer name data).

As per claims 50, 51 Perkowski discloses:

Transmission/Mean for transmitting from a consumer to a retailer website, (Col. 11, line 64-Col. 12, line 5, shows a plurality of User (or Client) Computers being connected to the Internet and available to consumers, Manufacturers, and Retailers, w/ Col. 15, lines 1-4, lines 19-27, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework);

Transmission/Mean for transmitting from the retailer website to a remote website, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, in this case, the retailer website is shown by the Client Computer, and the remote website is

Art Unit: 3623

shown by the Web-Based Document Server since it is remote to the Remote Client),
and

Transmission/Mean for transmitting from the remote website to the to the
retailer website, of a list of manufacturer incentives, (Col. 11, lines 37-40, shows that a
central UPC/URL database Subsystem serves the consumer product information
to retailers, w/ Col. 13, lines 2-9, where it is also shown that he Web based document
server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with
the UPC/URL database to serve the consumer product information to retailers, w/ Col.
6, lines 50-58, the list is shown by categorizing and graphically displaying product
information which also includes Product Incentives).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Perkowski (US Patent 5,950,173).

As per claim 27, 39, Perkowski discloses:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive/means for transmitting...(Col. 15, lines 19-44, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework which includes search button);

transmitting from said Web site of said manufacturer to said remote site said selection data/means for transmitting from said Web site...(Col. 15, lines 37-40, IPI finding an serving subsystem is the remote site);

transmitting from said Web site of said manufacturer to said consumer computer details/means for transmitting from said Web site of said manufacturer, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, *in this case, the consumer computer is shown by the Client Computer*, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client, w/ Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, where the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve

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the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers).

The following is obvious with Perkowski:

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive/means for transmitting from said remote site...(Col. 15, lines 37-40, obvious that details are transmitted to the manufacturer since the browser ultimately displays Web pages served from the IPD server and associated with the Search mode);

It would have been obvious to one of ordinary skill in the art to transmit from said remote site to said Web site of said manufacturer details of the selected at least one

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manufacturer incentive with the motivation ensuring that significant details of manufacturer selection data are sent to the correct location.

8. Claims 29 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (US 5,950,173), and further in view of Sloane (US Patent 5,918,211),

As per claims 29, 41, Perkowski fails to disclose transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification, but does disclose the transmission of manufacturer's incentives to consumers in Col. 12, lines 16-20.

However, Sloane discloses:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request/means for transmitting a user identification...determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification/means for determining manufacturer's incentives, (Col. 9, lines 52-58, Claim 12, Claim 15, shows usage of consumer identification in conjunction with transmitting consumer product information). Sloane discloses this limitation in an analogous art for the purpose of showing that a consumer identification can affect the transmittal of consumer product information.

It would have been obvious to one of ordinary skill in the art at the time of the

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applicant's invention to transmit a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification with the motivation of sending the consumer an incentive which is identified by consumer id.

9. Claims 31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (US 5,950,173), and further in view of Smolen (US Patent 5,915,243).

As per claims 31, 43, Perkowski fails to teach wherein said region data is postal code data, but does disclose region data through URLs in col. 11, lines 42-43.

However Smolen discloses:

wherein said region data is postal code data, (Col. 4, lines 64-67, represented by postal code). Smolen discloses this limitation in an analogous art for the purpose of showing that postal code data can be incorporated into a system for transmitting incentives.

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine the location of the retailer versus the location of the user for incentive transmittal purposes.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

- Application/Control Number: 09/505,632
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703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.
October 18, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Advisory Action

Application No.

09/505,632

Applicant(s)

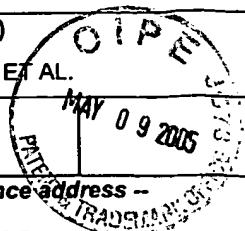
SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623



—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 7/2/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 24-31, 36-43 and 48-51.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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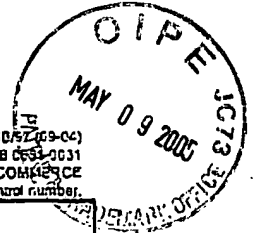
GROUP 3000

Continuation of 5. does NOT place the application in condition for allowance because: prosecution has been re-opened for this case and the examiner has cited new art..

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Application No. 09/505.632
Attorney Docket No. CAT/34-SCRO-CCP

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on 19 January 2005
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Robert G. Crockett
Signature

Robert G. Crockett

Typed or printed name of person signing Certificate

42 448

703-415-0012

Registration Number, if applicable

Telephone Number

The following papers are included in this facsimile transmission:

NOTICE OF APPEAL including Authorization to Charge Deposit Account (1 page in duplicate)

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

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This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 18 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form call 1-800-PTO-9198 and select option 2.



NEIFELD REF.: CAT/34-SCRO-CCP

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JAN 19 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: MICHAEL C. SCROGGIE ET AL.

GAU: 3623

SERIAL NO: 09/505,632

EXAMINER: ROBINSON-BOYCE,

A.

FILED: February 16, 2000

FOR: System and Method for Distributing Information Through Cooperative Communication
Network Sites

37 CFR 41.31 NOTICE OF APPEAL

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

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SIR:

Applicants hereby appeal to the Board of Appeals from the office action dated 21 October 2004.

The items checked below are appropriate:

- ☐ A Petition for Extension of Time Under 37 C.F.R. §1.136 was filed for _____ months.
- ☐ A timely response to the final rejection was filed on _____, as provided in 841 O.G. 1411.
- ☐ An Appeal Brief is being filed herewith.
- ☐ A Petition for Extension of Time for filing the Notice of Appeal is attached.
 - ☐ Applicant claims small entity status. See 37 C.F.R. §1.27.
 - ☐ 37 C.F.R. § 41.20(b)(1) Notice of Appeal fee of \$500.00 is enclosed.
 - ☐ 37 C.F.R. § 41.20(b)(2) Appeal Brief fee of \$500.00 is enclosed.

Total Appeal fees enclosed: -0-.

- ☒ Please charge any additional fees or credit any overpayment of fees required for filing the Notice of Appeal to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.
- ☒ If this notice is not considered timely filed by the U.S. Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 50-2106. A duplicate copy of this Notice is enclosed.

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GROUP 3600

Respectfully Submitted,

19 JAN 2005
Date

Robert G. Crockett
Robert G. Crockett
Registration No. 42,448
Attorney of Record



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,632	02/16/2000	Michael C. Scroggie	CAT/34-SCRO-CCP	5917

31518 7590 04/06/2004
NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202



EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 04/06/2004

RESPONSE DUE: 7/6/04
REMINDER: 6/6/04
BAR DATE: 10/6/04

Please find below and/or attached an Office communication concerning this application or proceeding.

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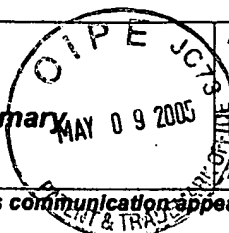
MAY 19 2005

GROUP 3600

Handwritten signature/initials: *[Signature]*

0A-CAT34SCROCCP-040407 CB

Office Action Summary



Application No.

09/505,632

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 24-31, 36-43, 48-51 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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GROUP 3600

DETAILED ACTION

Status of Claims

1. The following office action is in response to an amendment submitted after a decision by the Board of Patent Appeals and Interferences, which was affirmed. The following is a final office action. Claim 34 and 46 have been cancelled. Claims 50 and 51 have been added. Claims 1-24-31, 36-43 and 48-51 are pending in this application and have been examined on the merits.

Claim Objections

2. Claims 50 and 51 are objected to because of the following informalities: in the 3rd line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50 and 51 recites the limitation "transmission from the a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "mean for transmitting from the a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 28, 40, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 40, Sloane discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 7, lines 13-22);

Art Unit: 3623

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 8, lines 3-7).

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website, (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35

U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:

transmitting...at least one name.../means for transmitting...at least one name...(Col. 11, lines 1-9 read with Col. 13, lines 5-10).

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the

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desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffinan, et al discloses: transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details.../means for transmitting from said remote site...(Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(Col. 6, lines 62-63).

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It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 9, lines 52-58, Claim 12, Claim 15).

9. Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data

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can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data...(Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.
April 2, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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